

**REMARKS**

This paper is being filed in response to the Office Action dated December 16, 2003 that was issued in connection with the above-identified patent application. Applicant encloses herewith a Petition for Extension of Time pursuant to 37 C.F.R. §1.136(a) and the fee required under 37 C.F.R. §1.17(a)(3). Applicant respectfully requests reconsideration of the instant application in view of the amendments and remarks presented herein.

Claims 1 and 17-39 are pending in the instant application. Claim 40 has been added herein. New claim 40 is fully supported by the application as filed by, *inter alia*, page 3, line 1 to page 4, line 15 and claim 1, and therefore, does not constitute new matter. Thus, claims 1 and 17-40 will be pending upon entry of the instant amendment.

**1. Obviousness Rejection of Claims 1 and 17-39 Should Be Withdrawn**

Claims 1 and 17-39 have been rejected under 35 U.S.C. § 103(a) as allegedly obvious over:

Japanese Patent Application No. JP 52127936 by Hiraiwa Daiku KK published October 27, 1977 (hereinafter "Hiraiwa Daiku")

in view of

Japanese Patent Application No. JP55152003 by Yoshitomi Pharm Ind KK published November 27, 1980 (hereinafter "Yoshitomi"),

Japanese Patent Application No. JP05017732 by Yamauchi T. published January 26, 1993 (hereinafter "Yamauchi"),

International Patent Publication No. WO 95/22902 by Kodama et al. published August 31, 1995 (hereinafter "Kodama"), and

German Patent Application No. DE 3536417 by Metzner et al. published November 19, 1992 (hereinafter "Metzner").

The Examiner has alleged that Hiraiwa Daiku teaches a wood adhesive composition consisting essentially of a suitable amount of insecticide and an adhesive.

While the Examiner has acknowledged that Hiraiwa Daiku fails to teach the specific pyrazole compound and some of the specific adhesive resins of the invention, the Examiner has alleged that these compounds are taught by the remaining references cited. In particular, the Examiner has alleged that Kodama discloses insecticidal pyrazole compounds and Yoshitomi, Yamauchi, and Metzner disclose the resin compounds not taught by Hiraiwa Daiku. In addition, the Examiner has alleged that a person of ordinary skill in the art would have been motivated to modify Hiraiwa Daiku by employing the insecticides and specific resins of the instant claims in the composition of Hiraiwa Daiku since these insecticides and resins were known in the art. More specifically, the Examiner has alleged that the insecticides described by formula I were known to be effective against termites and useful in wood products. In addition, the Examiner has alleged that the specific adhesives were known to be useful as wood adhesives and, therefore, has viewed the selection of an adhesive resin to be choice from amongst equally suitable materials. The Examiner has further alleged that the standard for obviousness is not predictability, but rather a “reasonable expectation of success.” Accordingly, the Examiner has alleged that since Hiraiwa Daiku does not limit the identity of the pesticide that may be used and fipronil was known to be an insecticide useful against termites, one of ordinary skill in the art would have a reasonable expectation that fipronil would be useful in a termicidal wood adhesive. The Examiner has concluded that it would have been obvious to one of ordinary skill in the art to combine the teachings of Hiraiwa Daiku, Kodama, Yoshitomi, Yamauchi, and Metzner to arrive at the claimed invention.

Applicant traverses these rejections and asserts that the instant claims would not have been obvious in view of the cited documents. Applicant asserts that the instant claims are not obvious over the cited documents because (i) they fail to suggested to one of ordinary skill in

the art that they should make the claimed composition; and (ii) one of ordinary skill in the art would not have had a reasonable expectation of success using the claimed combination.

"Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under §103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)

Further, to render an invention obvious, the asserted references must be viewed without the benefit of hindsight gleaned from the Applicant's disclosure. *See e.g.* MPEP § 2141. Thus, a combination of references will not render an invention obvious if they supply nothing more than a motivation to attempt the combination. *See e.g. In re O'Farrell*, 853 F.2d 894, 902 (Fed. Cir. 1988)(the Court of Appeals for the Federal Circuit and its predecessors have repeatedly rejected "obvious to try" as the standard for obviousness).

A Declaration under 37 C.F.R. 1.132 by inventor, Sylvestre Jobic, was filed on October 29, 2003 in connection with this application. However, the Examiner made no express reference to Mr. Jobic's Declaration in the most recent Office Action. Upon telephoning the Examiner, the Examiner indicated that he had not received the Declaration and, therefore, had not considered it in preparation of the outstanding Office Action. Applicant has enclosed a duplicate copy of the Declaration filed October 29, 2003 for the Examiner's convenience and, respectfully requests reconsideration of the pending claims in view of the information presented therein.

In particular, Applicant respectfully invites the Examiner's attention to paragraph 5 of the Declaration, wherein Mr. Jobic states that "whether the insecticidal property of a specific insecticide and the adhesive property of a specific adhesive resin are preserved when the insecticide and adhesive resin are mixed together is not predictable." Moreover, in paragraph 6 of the Declaration, Mr. Jobic attests to the fact that "a person of ordinary skill in the art could not predict, at the time of filing of the instant application, whether any random combination of insecticide and adhesive resin would exhibit commercially effective adhesive and insecticidal properties."

Thus, Applicant asserts that even if one of ordinary skill in the art would have been motivated to try serially mixing *all possible insecticides* with *all possible adhesives* until the claimed combination was produced, since none of the cited documents disclose, or suggest, which insecticides and which adhesives are likely to retain their respective properties upon being combined, this is insufficient to render the instant claims obvious. Indeed, according to the Manual of Patent Examining Procedure, the admonition that "obvious to try" is not the standard applies where "what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result...and the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful." See *e.g.* MPEP § 2145, paragraph X.B.

Thus, regardless of whether fipronil is "an old well-known insecticide," the primary reference relied upon (*i.e.*, Hiraiwa Daiku) does not teach its use in an adhesive mixture. In fact none of the asserted documents teach or suggest which adhesives and which insecticides would be expected to retain their respective properties. Moreover, the level of skill in the art cannot be relied upon, in itself, to overcome this deficiency. See, *e.g.*, *Al-Site Corp. v. VSI Int'l Inc.*, 174

F.3d 1308, 1325, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.); *see also* M.P.E.P. §2143.01.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1 and 17-39.

## **2. New Claim 40 Is Not Obvious over the Cited Documents**

In order to establish a *prima facie* case of obviousness with a combination of references, the references must teach or suggest each and every limitation of the claims. *See e.g.* MPEP § 2142. Moreover, the references must disclose the invention in as complete detail as claimed or suggest the desirability of making any required modification. *See e.g.* MPEP § 2143.01. Regarding new claim 40, Applicant asserts that neither Kodama, nor any of the other references disclose the following functional groups:

$R_1 = \text{methyl};$

$R_4 = -\text{H}, -\text{NR}_5\text{R}_6, -\text{S}(\text{O})_m\text{R}_7, -\text{C}(\text{O})\text{R}_7, -\text{C}(\text{O})\text{O}-\text{R}_7, -\text{OR}_8, \text{ or a } -$

$\text{N}=\text{C}(\text{R}_9)(\text{R}_{10}) \text{ radical};$

$R_{11} = -\text{H};$

$\text{X} = \text{a trivalent nitrogen atom or } -\text{C}-\text{R}_{12} \text{ (where } \text{R}_{12} = \text{H}); \text{ or}$

$\text{R}_{13} = -\text{S}(\text{O})_q\text{CF}_3;$

Since none of the documents cited teach or suggest these functional groups, they fail to disclose the present invention as claimed. Hence, claim 40 is not obvious in view of the cited documents.

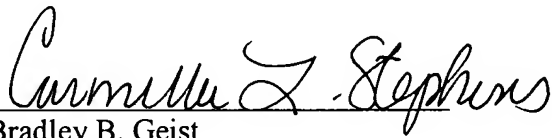
## **CONCLUSION**

In summary, Applicant believes that claims 1 and 17-40 are in condition for allowance and, accordingly, respectfully solicits prompt favorable action. Applicant encloses

herewith the fee required under 37 C.F.R. § 1.16(c) and 1.17(a)(3). While Applicant does not believe that any additional fees are required with this paper, the Commissioner is hereby authorized to charge any fees necessitated by this submission not otherwise enclosed herewith to Deposit Account No. 02-4377. Please credit any overpayment of fees associated with this filing to the above-identified deposit account. A duplicate of this page is enclosed.

Respectfully submitted,

June 16, 2004

  
Bradley B. Geist  
PTO Reg. No. 27,551

Carmella L. Stephens  
PTO Reg. No. 41,328  
Attorneys for Applicant

Guy F. Birkenmeier  
PTO Reg. No. 52,622  
Agent for Applicant

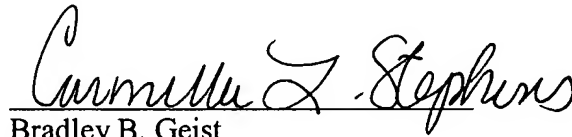
BAKER BOTTS, L.L.P.  
30 Rockefeller Plaza  
New York, NY 10112  
(212) 408-2500

Enclosure

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Bradley B. Geist  
PTO Reg. No. 27,551

Carmella L. Stephens  
PTO Reg. No. 41,328  
Attorneys for Applicant

Guy F. Birkenmeier  
PTO Reg. No. 52,622  
Agent for Applicant

BAKER BOTTS, L.L.P.  
30 Rockefeller Plaza  
New York, NY 10112  
(212) 408-2500

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